

AF
IPV

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number 10/000,170

Filing Date November 30, 2001

First Named Inventor Peter Zatloukal

Art Unit 2135

Examiner Name Truong, Thanhnga B.

Attorney Docket Number 109909-129555

ENCLOSURES (Check all that apply)☐ Fee Transmittal Form☐ Fee Attached☐ Amendment/Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Reply to Missing Parts/
Incomplete Application☐ Reply to Missing Parts
under 37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a
Provisional Application
☐ Power of Attorney, Revocation
☐ Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) _____☐ Landscape Table on CD☐ After Allowance Communication to TC☐ Appeal Communication to Board
of Appeals and Interferences☒ Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s) (please identify
below):

Return Receipt Postcard

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name Schwabe, Williamson & Wyatt, P.C.

Signature

Printed name Robert C. Peck

Date October 18, 2006

Reg. No. 56,826

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name Yvette L. Chriscaden

Date October 18, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Attorney Reference: 109909-129555
IPG No: P010

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Zatloukal et al.

Application No.: 10/000,170

Filed: November 30, 2001

For: **SYSTEM AND METHOD FOR
DISPLAYING SUBSCRIBER
LOCATIONS ON MOBILE
STATIONS**

Examiner: Truong, Thanhnga B.

Art Unit: 2135 Conf. No. 9518

I hereby certify that this correspondence is being deposited
with the United States Postal Service as **First Class Mail** in
an envelope addressed to: Commissioner for Patents,
Washington, D.C. 20231 on this date:

October 18, 2006
DATE

Yvette L. Chriscaden
TYPED OR PRINTED NAME

Yvette L. Chriscaden
SIGNATURE

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER

Dear Sir:

Appellants respectfully reply to the Examiner's answer as follows:

(A) In "Response to Argument," part I, the Examiner maintains that claims 1, 17-20, 36, 52-59, and 73-77 were properly rejected as anticipated by Lam under 35 U.S.C. §102(e). More specifically, on pages 18-19 of the Examiner's Answer, the Examiner asserts that when the "authenticating" and "eligible" language recited by claim 1 are given their broadest meanings, the identification unit of Lam anticipates claim 1. According to the Examiner, this unit "identifies on the functional faceplate by accepting the identification code ... as part of the *authenticating* process to establish the identity, or ascertain the origin, nature, or definitive characteristics of the *eligible* cover of the faceplate" (Examiner's Answer, pg. 19) (emphasis added).

First, it is worth noting that the italicized words of the Examiner do not appear anywhere in Lam. Lam simply does not recite the authenticating of a cover as an eligible cover, or disclose operations equivalent to such recitations. Appellants readily acknowledge that both “authenticating” and “eligible” should be read as having broad ranges of meanings. But even reading those terms in light of their broadest possible meanings, Lam still fails to teach anything more than a cover identifying itself, and the base portion interpreting the signals in light of the identification.

Perhaps definitions would clarify this discussion. To authenticate something is to “establish the authenticity of something”, wherein “authenticity” means “genuine” or “legitimate.” *Word Reference.com, English Dictionary*, at <http://www.wordreference.com/definition>. According to the same source, “eligible” means “qualified for or worthy of being chosen.” *Id.* “Identify”, on the other hand, simply means to establish the “identity of someone or something.” *Id.*

Thus, reading the contested limitations as broadly as is possible, “authenticating the ... cover as an eligible cover” requires that some operation be performed ensuring that the cover is genuinely an “eligible cover,” wherein an “eligible cover” is a cover that meets certain qualifications. Lam simply does not disclose any such operations. The passage quoted by the Examiner (column 9, lines 32-41 of Lam) teaches a faceplate communicating its identity or type to a device. The device then uses the identification to interpret the signals generated by the faceplate. Thus, Lam simply teaches the faceplate identifying itself, telling a device who/what it is. No mention is made of the device then authenticating/verifying the received identification to ensure that the faceplate is genuinely a “qualified” faceplate. Any faceplate that can fit on the device and communicate an authentication appears to be acceptable under Lam’s disclosure.

Further, this difference between the invention of claim 1 and Lam is clarified when claim 1 is viewed in light of its purpose. The purpose of claim 1 is to prevent the use of a base portion with a counterfeit interchangeable cover. Lam, in contrast, makes no recognition of the problem posed by counterfeit covers or any provision for ensuring that the attached faceplates are not counterfeit.

Accordingly, claim 1 is not anticipated by Lam under §102(e).

Claims 36 and 59 recite similar limitations, and are those patentable over Lam for at least the same reasons.

Claims 17-20, 52-58, and 73-77 depend from claims 1, 36, and 59 respectively, incorporating their limitations. Accordingly, claims 17-20, 52-58, and 73-77 are patentable for at least the same reasons.

Also, on page 8 of Appellants' Appeal Brief, Appellants make a number of additional arguments regarding the patentability of claims 19-20 and 54-55. The Examiner did not reply to these arguments in the Examiner's Answer. Accordingly, Appellants assume that the Examiner agrees with Appellants regarding the patentability of these claims, and request that the Examiner allow claims 19-20 and 54-55.

(B) In "Response to Argument," part II, the Examiner maintains that claims 2-7, 10-11, 13-16, 21-26, 29-33, 37-42, 45-46, 48-51, 60-65, and 68-72 were properly rejected as obvious under 35 U.S.C. §103(a) in view of Lam and Reed III. In maintaining the rejection, the Examiner referred to the arguments discussed in Part A above and discussed the contribution of Reed III (hereinafter "Reed").

In response, Appellants note that Reed does not cure the deficiencies of Lam, discussed in Part A above. Thus, even assuming that the Examiner is correct in his description of Reed and its contribution, Lam and Reed combined do not teach or suggest each and every limitation of claim 1, as is required. Accordingly,

for at least the reasons provided in Part A above, claim 1 remains patentable over Lam and Reed, alone or in combination, under §103(a).

Claim 21 is an independent claim having language similar to that of claim 1. Accordingly, for at least the same reasons, claim 21 is patentable over Lam and Reed, alone or in combination. Claims 36 and 59, rejected as anticipated by Lam under §102(e), also remain patentable when Lam is combined with Reed, as Reed does not cure the deficiencies of those claims.

Claims 2-7, 10-11, 13-16, 22-26, 29-33, 37-42, 45-46, 48-51, 60-65, and 68-72 depend from claims 1, 21, 36, and 59 respectively, incorporating their limitations. Accordingly, for at least the same reasons, claims 2-7, 10-11, 13-16, 22-26, 29-33, 37-42, 45-46, 48-51, 60-65, and 68-72 are patentable over Lam and Reed, alone or in combination, under §103(a).

Also, on pages 9-10 of Appellants' Appeal Brief, Appellants make a number of additional arguments regarding the patentability of claims 13, 15-16, 30, 32-33, 48, 50-51, 69, and 71-72. The Examiner did not reply to these arguments in the Examiner's Answer. Accordingly, Appellants assume that the Examiner agrees with Appellants regarding the patentability of these claims, and request that the Examiner allow claims 13, 15-16, 30, 32-33, 48, 50-51, 69, and 71-72.

(C) In "Response to Argument," part III, the Examiner maintains that claims 8-9, 12, 27-28, 43-44, 47, and 66-67 were properly rejected as obvious under 35 U.S.C. §103(a) in view of Lam, Reed, and Chen. In maintaining the rejection, the Examiner referred to the arguments discussed in Parts A and B above and discussed the contribution of Chen.

In response, Appellants note that Chen does not cure the deficiencies of Lam and Reed, discussed in Part B above. Thus, even assuming that the Examiner is correct in his description of Chen and its contribution, Lam, Reed, and Chen combined do not teach or suggest each and every limitation of claim 1, as is

required. Accordingly, for at least the reasons provided in Parts A and B above, claim 1 remains patentable over Lam, Reed, and Chen, alone or in combination, under §103(a).

Claim 21 is an independent claim having language similar to that of claim 1. Accordingly, for at least the same reasons, claim 21 is patentable over Lam, Reed, and Chen, alone or in combination. Claims 36 and 59, rejected as anticipated by Lam under §102(e), also remain patentable when Lam is combined with Reed and Chen, as Chen does not cure the deficiencies of those claims.


Claims 8-9, 12, 27-28, 43-44, 47, and 66-67 depend from claims 1, 21, 36, and 59 respectively, incorporating their limitations. Accordingly, for at least the same reasons, claims 8-9, 12, 27-28, 43-44, 47, and 66-67 are patentable over Lam, Reed, and Chen, alone or in combination, under §103(a).

Conclusion

As Applicant has set forth in the brief, the Examiner has erred in his rejections. Accordingly, Applicant respectfully requests that the Board reverse the Examiner's rejections.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
Schwabe, Williamson & Wyatt, P.C.

A handwritten signature in black ink, appearing to read 'Robert C. Peck', written over a horizontal line.

Robert C. Peck, Reg. No. 56,826
Agent for Appellant

Date: October 18, 2006

Pacwest Center
1211 SW Fifth Ave., Ste 1600-1900
Portland, Oregon 97204
Phone: (503) 222-9981,
FAX: (503) 796-2900